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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,720	01/12/2001	Scott Eisenberg	2624-004	2443

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EXAMINER

VAUGHAN, MICHAEL R

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/759,720

Applicant(s)

EISENBERG, SCOTT

Examiner

Michael R Vaughan

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 1-39 have been examined and are pending.

### ***Claim Rejections - 35 USC ' 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman (USP 5,499,294).

As per claims 1, 17, and 26, Friedman teaches a method of administering distribution of electronic digital copies of a literary work, the method comprising: receiving from a user a digital signature having properties that correspond to one or more attributes of a physical object bearing a recording of the literary work; revealing

the one or more attributes of the physical object from the digital signature; determining, based on the one or more attributes of the physical object, whether the user has physical possession of the physical object; and selectively making accessible to the user electronic digital services concerning the literary work based on the determination of whether the user has physical possession of the physical object (col. 4, lines 19-67).

As per claim 9, Friedman teaches a computer system adapted to administer distribution of electronic digital copies of a literary work, the computer system comprising: a processor; and a memory electronically connected to the processor, the memory including software instructions adapted to enable the computer system to perform operations comprising: receiving from a user a digital signature having properties that correspond to one or more attributes of a physical object bearing a recording of the literary work; revealing the one or more attributes of the physical object from the digital signature; determining, based on the one or more attributes of the physical object, whether the user has physical possession of the physical object; and selectively making accessible to the user electronic digital services concerning the literary work based on the determination of whether the user has physical possession of the physical object (col. 4, lines 19-67).

As per claims 2 and 10, Friedman teaches the electronic digital services comprise distributing an electronic digital copy (col. 5, lines 10-13).

As per claims 3 and 11, Friedman teaches the electronic digital services comprises providing streaming audio (col. 5, lines 12-13).

As per claims 4 and 12, Friedman teaches wherein the one or more attributes of the physical object are revealed by performing a cryptographic transformation on the digital signature (col. 6, lines 3-5).

As per claims 5 and 13, Friedman teaches wherein the one or more attributes of the physical object comprise errors (col. 10, lines 3-9).

As per claims 6 and 14, Friedman teaches the physical object is a CD and the one or more attributes of the physical object comprise the number of tracks on the CD and the length of each track (col. 11, lines 13-18).

As per claims 7 and 15, Friedman teaches the physical object is a CD and the one or more attributes of the physical object comprise extended track data (col. 11, lines 13-18).

As per claims 8 and 16, Friedman teaches the one or more attributes of the physical object comprise a serial number (col. 8, lines 2-3).

As per claims 18 and 27, Friedman teaches downloading to the true owner a digital electronic copy of works recorded on the recording item (col. 3, lines 5-9).

As per claims 19 and 28, Friedman teaches the digital electronic copy is in MP3 format (col. 14, lines 4-10).

As per claims 20 and 29, Friedman teaches the digital electronic copy is in WMA format (col. 14, lines 4-10).

As per claims 21 and 30, Friedman teaches the digital electronic copy is in RealAudio format (col. 4, lines 5-9).

As per claims 22 and 31, Friedman teaches adding a copy of the works recorded on the recording item to central data storage for downloading to true owners of legitimate copies of the recording item (col. 4, lines 16-19).

As per claims 23 and 32, Friedman teaches the electronic signature is an electronic hash of information selectively extracted from the recording item (col. 14, lines 5-10).

As per claims 24 and 33, Friedman teaches wherein determining whether the recording item is unique to the Putative owner is done based on attributes of the recording item (col. 6, lines 5-7).

As per claims 25 and 34, Friedman teaches the attributes of the recording item on which the determination of uniqueness are based comprise errors (col. 13, lines 8-9).

As per claim 35, Friedman teaches a system for granting electronic rights concerning a physical media bearing entertainment content, the system comprising: a media signature detection module for reading and detecting a media signature on the physical media; and a media signature judgment module for determining a specific title corresponding to entertainment borne on the physical media; wherein electronic rights are granted to a person who owns the physical media, based on the determining a specific title corresponding to entertainment borne on the physical media (col. 4, lines 17-65).

As per claim 36, Friedman teaches wherein the media signature detection module is present on a user computer and the media signature judgment module is present on a service provider computer (col. 4, lines 10-20).

As per claim 37, Friedman teaches the media signature detection module comprises a software application implemented on a computer (col. 6, lines 13-19).

As per claim 38, Friedman teaches the media signature judgment module comprise a software application implemented on a computer (col. 6, lines 20-21).

As per claim 39, Friedman teaches the media signature judgment module includes a comparator connected to make a comparison of a user provided signature to a signature from a media storage database (col. 12, lines 1-5).



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Vaughan whose telephone number is 703-305-0354. The examiner can normally be reached on M-F 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MV  
Michael R Vaughan

Examiner

Art Unit 2131

  
**AYAZ SHEIKH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**